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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,183	01/13/2000	Daniel R. Tretter	10980251-1	8066

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Ip Administration
Legal Department 20bn
Hewlett-Packard Company
P O Box 10301
Palo Alto, CA 94303-0890

EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/483,183

Applicant(s)

TRETTER ET AL.

Examiner

Christopher J. Brown

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by DeBry US 6,385,728.

As per claim 12,

1 DeBry teaches a method using a printer to distribute a document stored on a server, the server being connected to a network, (Col 5 lines 34-39). DeBry teaches using at least one cryptographic key to establish itself with the server, (Will Call certificate with key) (Col 7 lines 40-49). DeBry teaches using the printer to decrypt and encrypted document

from the network, (Col 10 lines 18-21). DeBry teaches the printer prints a decrypted document, (Col 10 lines 42-44).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 5, 6, 9, 10, 13, 15, 16, 19, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897

As per claims 1, 3, 16, 19 DeBry teaches a method using a printer to distribute a document stored on a server, the server being connected to a network, (Col 5 lines 34-39). DeBry teaches using at least one cryptographic key to establish itself with the server, (Will Call certificate with key) (Col 7 lines 40-49). DeBry teaches using the printer to decrypt and encrypted document from the network, (Col 10 lines 18-21). DeBry teaches the printer prints a decrypted document, (Col 10 lines 42-44).

DeBry does not disclose using a smart card with the printer.

Mandelbaum teaches use of a smart card interface with a printer, in which the smart card sends a message including a key, to the printer, (Col 4 lines 18-23). It would have been obvious to one of ordinary skill in the art to use the smart card to Mandebaum with the key of DeBry because the smart card enhances security and eliminates the chance of a network attack.

As per claims 4, and 15 Debry does not disclose a smart card.

Mandelbaum discloses a smart card reader with a printer (facsimile) where the smart card performs decryption for the printer, (Col 3 lines 35-40, 60-64).

It would be obvious to combine Mandelbaum's smart card with the modified DeBry because the smart card provides secure encryption keys.

As per claim 5, DeBry teaches the printer is used to perform decryption, (Col 10 lines 42-44).

As per claim 6, Debry teaches ordering the document prior to establishing a printer identity, (Col 9 lines 37-40).

As per claim 9, DeBry teaches using at least one cryptographic key to authenticate the printer prior to ordering the document, (Col 9 lines 51-61).

As per claim 10, 23 DeBry teaches using the printer to render (print) the decrypted document, (Col 10 lines 42-44).

As per claim 13, DeBry teaches a client placing an order, (Col 6 lines 10-14).

Claims 2, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Furman US 5,483,653.

2. As per claim 2, and 22 DeBry as modified above, discloses sending an encrypted document to a printer. DeBry does not disclose a message that indicates the number of copies to be printed.

Furman discloses a message send with a document (job ticket) that indicates the number of copies to be printed, where the printer prints the number of document copies indicated in the message, (Col 6 lines 26-31, Col 7 lines 7-12, 32-35, Fig 3).

It would be obvious to modify DeBry's encryption of documents with Furman's printer instructions because it provides the printer with needed instruction.

Claims 11, and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

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As per claim 11, and 21, It would be obvious that DeBry-Mandelbaum combination disclosed printer would contain a status display. DeBry-Mandelbaum does not disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify DeBry-Mandelbaum's print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

It would have been obvious for one of ordinary skill in the art to modify the previous combination with Boyles charging because it allows for a more versatile economic model for DRM.

Claim 17, is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Furman US 5,483,653 in view of Boyles's US 6,738,901

As per claim 17, It would be obvious that DeBry's disclosed printer would contain a status display. DeBry does not disclose that the display shows the status of the copies printed.

Furman discloses that the user can determine the status of printing through the server, (Col 4 lines 20-24).

It would be obvious to modify DeBry's print system with Furman's status screen because it provides lets the user know when his print jobs are complete.

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Boyles teaches a network printer that registers a cost with a server for every copy printed, (Col 9 lines 18-21).

It would have been obvious for one of ordinary skill in the art to modify the previous combination with Boyles charging because it allows for a more versatile economic model for DRM.

Claims 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Peairs US 5,717,940.

As per claim 7, The previous DeBry-Mandelbaum does not disclose that the printer is used to order the document.

Peairs discloses that the printer may be used to order the document, (Col 3 lines 10-23).

As per claim 8, the previous DeBry-Mandelbaum combination does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify DeBry-Mandelbaum print system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

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Claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Peairs US 5,717,940.

As per claim 14, DeBry does not disclose previewing at least one low quality document before ordering.

Peairs discloses a server that stores low quality document previews, (Col 4 lines 25-27, 57-59).

It would be obvious for one skilled in the art to modify DeBry's printing system, with de Peairs preview system because seeing a preview allows a user to easily select the document they are seeking.

Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry US 6,385,728 in view of Mandelbaum US 5,552,897 in view of Choudury US 5,509,074

As per claim 20, The previous DeBry-Mandelbaum combination does not disclose receiving an order from a printer keypad.

Choudhury discloses the printer has a keypad where the document may be obtained using the keypad, (Col 4 lines 26-30).

It would have been obvious to one of ordinary skill in the art to use the keypad of Choudhury in the printer system of Debry-Mandelbaum because ordering directly from the printer eliminates the need for other hardware.

Allowable Subject Matter

Claim 18 is allowable over the prior art. Claim 18 claims a printer for receiving an encrypted token from a remote site, means for using a decryption key to decrypt the token and means for sending the decrypted token to the remote site. These statements overcome the current prior art of record.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

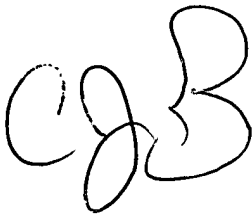

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher J Brown

5/25/05

A handwritten signature in black ink, appearing to be 'CJB'.A handwritten signature in black ink, appearing to be 'Greg Morse'.

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100